

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-6 remain in this application, and have been amended to clarify the claim language and to correspond to accepted U.S. practice. None of these claims have been amended in response to the references cited by the Examiner, because all of the claim features that are not taught by the references are found in the original claims.

Claims 7-16 have been added to this application. No new matter has been added by the additional claims.

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Riek (U.S. 5,987,179) in view of Gabriel (U.S. 5,973,755). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites:

control means for determining an area of the still picture data coded into the compressed moving picture data in response to a manipulation made from the user terminal, and for notifying the determined area to the moving picture coding means.

(lines 22-26). Neither of the cited references suggest the cited element. The Examiner cites Gabriel as teaching a "zooming" ability. However, the cited passages discuss how an encoded zoom operation would have no motion vector (see col. 7, lines 15-21). The discussed zoom is already in the video image, it is not the result of a manipulation from a user terminal. Thus, Gabriel does not teach the cited element.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references can be combined or

modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*). Merely stating that the combination is “obvious” is not motivation.

Thus, because no proper motivation has been provided, the rejection for obviousness is improper.

Thus, claim 1 is patentable over the references. Claims 2-3, which depend on claim 1, are patentable for the same reasons (as well as for the limitations contained therein).

Claim 4 contains a similar limitation, as discussed for claim 1, at lines 19-23. Thus, claim 4 is patentable over the references for the same reasons discussed for claim 1. Claims 5-6, which depend on claim 4, are patentable for the same reasons (as well as for the limitations contained therein).

New claims 7 & 13 recite “transmitting means for transmitting the compressed moving picture data to a mobile terminal” (lines 9-10). Neither of the references suggest this element of these claims. Thus, claims 7 & 13 are patentable over the references for the same reasons as discussed for claim 1.

Note that claim 13 recites an invention that makes it possible for a mobile terminal that is capable of displaying *moving pictures* (i.e., video) from compressed moving picture data (such as MPEG for example—see specification), to also display high-quality still pictures of many different formats. The processing and conversion can be done *outside* of the mobile device, but it allows a mobile terminal capable of displaying video in a given format to also display still pictures originating from data that is not compatible with the mobile device. In this manner, the mobile device becomes more useful. These features are not suggested by the references.

New claims 8-12, which depend, directly or indirectly, on claim 7, and new claims 14-16, which depend on claim 13, are all patentable over the references for the same reasons as their parent claims (as well as for the limitations contained therein).

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Further, new claim 16 recites a limitation similar to that discussed for claims 1 and 4, and thus claim 16 is patentable for those reasons as well.

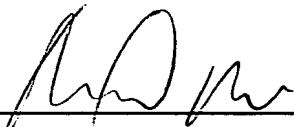
In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

A check in the amount of \$86.00 is enclosed to cover the fee for additional independent claims. If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32626.

Respectfully submitted,

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